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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,803	03/30/2005	Martin Muller	SE/2-22758/A/PCT	5356
324 7590 05/24/2007 CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			EXAMINER ABU ALI, SHUANGYI	
			ART UNIT 1755	PAPER NUMBER
			MAIL DATE 05/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,803	Applicant(s) MULLER ET AL.	
	Examiner Shuangyi Abu-Ali	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

(1)

Status of Claims

Claims 1 and 4-5 remain for examination wherein claims 1 and 4-5 are amended.

(2)

Response to Arguments

Applicant's arguments with respect to claims 1 and 4-5 over reference U. S. Patent 6,280,511 to Schaedeli et al. or/ and U. S. Patent 6,533,857 to Schmid et al. have been considered but are moot in view of the new ground(s) of rejection.

(3)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 5,840,449 to Zambounis et al., in view of U.S. patent 6,280,511 to Schaedeli et al.

Regarding claim 1, Zambounis et al. disclose a composition comprising a substrate and a latent pigment. The substrate can be metal, metal oxide and polymeric material in any kind of form and composition. The latent pigment can be

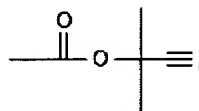


A is the radical of a chromophore of the quinacridone, anthraquinone, perylene, indigo, azo, quinophthalone, isoindolinone, isoindoline, dioxazine, phthalocyanine or diketopyrrolopyrrole series which contains nitrogen atoms attached to D_1 and to $x D_2$, each nitrogen atom present in A being able independently of the others to be attached to 0, 1 or 2 groups D_1 or D_2 ,

D_1 and D_2 are hydrogen, x is an integer from 0 to 4, and

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and especially those in which x is 1 and D₃ and D₄ are identical and are groups of the formula



Although they disclose that latent pigment can be deposited on the substrate by any desired technique, they are silent about the technique set forth in claim 1.

However, Schaedeli et al., also drawn to a composition comprising a polymeric material and a latent pigment, disclose a process to prepare a pigmented composition (col. Lines 7-13). A substrate is added into a solution comprising pigment precursors followed by precipitation of the pigment precursors thereon (col.28, lines 10-14). A suitable Broensted acid is then contacted with the substrate to convert the pigment precursors into pigment (col. 29, line 55-57). The latent pigment may have the following structure:



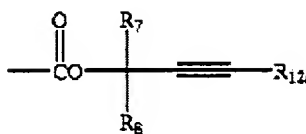
in which

A represents a residue of a colorant of the anthraquinone, azo, quinaeridone, quinophthalone, diketopyrrolopyrrole, dioxazine, indanthrone, indigo, isoindoline, isoindolinone, perylene, or phthalocyanine series, which is linked to x groups B via one or more of its hetero atoms, wherein such hetero atoms are selected from the group consisting of N, O or S, and are part of the molecular structure of A, and

B is either a hydrogen atom or a solubilizing group which can be split off by heat and/or a Broensted acid, with the proviso that at least one of the groups B in formula (I) is not a hydrogen atom, and

x is an integer from 1 to 8.

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R_{12} represents a hydrogen atom; $\text{C}_1\text{--C}_6$ alkyl or a group

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use Schaedeli et al. method to make Zambounis et al. composition, motivated by the fact that Schaedeli et al. disclose that their method has the advantage that the latent pigment precipitated very fast in the substrate and the pigment particles have a small size and uniform distribution (col. 28, lines 34-37).

Regarding claim 4, Zambounis et al. disclose the substrate is selected from an unlimited source such as metal, metal oxide, aluminum and coated steel (col. 15, lines 54-61).

Regarding claim 5, Schaedeli et al. disclose that the precipitation takes place when a liquid, which is insoluble to pigment precursors (col. 28, lines 26-33), is added into carrier system.

(4)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

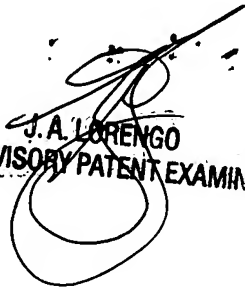
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shuangyi Abu-Ali whose telephone number is 571-272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SA



J.A. LORENZO
SUPERVISORY PATENT EXAMINER